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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,525	05/08/2006	Taro Kizu	SUG-06-1107	1361
35811 7590 11/24/2008 IP GROUP OF DLA PIPER US LLP ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103				
EXAMINER				
FOGARTY, CAITLIN ANNE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
11/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,525

**Applicant(s)**

KIZU ET AL.

**Examiner**

CAITLIN FOGARTY

**Art Unit**

1793

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CIS)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1 – 6 are pending where claims 1, 3, 4, and 6 have been amended.

### ***Status of Previous Rejections***

2. The 35 U.S.C. 103(a) rejection of claims 1 – 3 as being unpatentable over Matsuoka et al. (US 2003/0111144) has been maintained.

The 35 U.S.C. 103(a) rejection of claims 4 – 6 as being unpatentable over Matsuoka et al. (US 2003/0111144) in view of JP 05-255804 has been maintained.

The provisional rejection of claims 1 – 6 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 6 of copending Application No. 10/578,524 has been withdrawn in view of the Terminal Disclaimer filed August 4, 2008.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1 – 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuoka et al. (US 2003/0111144).

Matsuoka is applied to instant claims 1 - 3 as discussed in the April 2, 2008 Office action.

With respect to the amended feature of instant claims 1 and 3, [0093]-[0133] of Matsuoka describe in detail the composition of the high-strength thin

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steel sheet. More specifically, [0131] teaches that the high-strength thin steel sheet may contain up to 0.1 mass% B which overlaps with the range recited in instant claim 1. The specific examples of steel alloys of Matsuoka cited in the April 2, 2008 Office action do not teach the composition of B and therefore are no longer within the compositional ranges recited in instant claim 1.

Since the claimed compositional ranges of claims 1 – 3 either overlap or are within the ranges disclosed by Matsuoka, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed steel alloy composition from the steel alloy composition disclosed by Matsuoka because Matsuoka teaches the same utility (i.e. automobile body parts) in the whole disclosed range.

5. Claims 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuoka et al. (US 2003/0111144) in view of the machine English translation of JP 05-255804 from the IDS (hereafter JP '804).

Matsuoka in view of JP '804 is applied to instant claims 4 - 6 as discussed in the April 2, 2008 Office action.

With respect to the amended feature of instant claims 4 and 6, [0093]-[0133] of Matsuoka describe in detail the composition of the high-strength thin steel sheet. More specifically, [0131] teaches that the high-strength thin steel sheet may contain up to 0.1 mass% B which overlaps with the range recited in instant claim 4. The specific examples of steel alloys of Matsuoka cited in the

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April 2, 2008 Office action do not teach the composition of B and therefore are no longer within the compositional ranges recited in instant claim 4.

Since the claimed compositional ranges of claims 4 – 6 either overlap or are within the ranges disclosed by Matsuoka, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed steel alloy composition from the steel alloy composition disclosed by Matsuoka because Matsuoka teaches the same utility (i.e. automobile body parts) in the whole disclosed range.

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1 – 6 have been considered but are moot in view of the new ground(s) of rejection.

Arguments are summarized as follows:

- a. The Applicants' claims 1 – 3 require B being present in an amount of 0.0005-0.0030%. The Applicants respectfully submit that Matsuoka fails to disclose the presence of B at all.
- b. The Applicants' claims 4 – 6 require B being present in an amount of 0.0005-0.0030%. The Applicants submit that neither Matsuoka nor JP '804 disclose the presence of B.

Examiner's responses are as follows:

- a. – b. See 35 U.S.C. 103(a) rejections above directed to the amended features of claims 1- 6.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

CF